



PATENTS

UNITED STATES PATENT AND TRADEMARK OFFICE

S/N:	10/644,571	Examiner:	Esabella, David J.
Filed:	August 20, 2003	Art Unit:	3738
Inventor:	Robert Hugh McKenna	Docket:	21680 - 0515143
Title:	Method and Apparatus to Facilitate Nutritional Malabsorption		

RESPONSE TO RESTRICTION REQUIREMENT

This paper is being filed in response to the Restriction Requirement mailed on 03/17/2005.

Applicant traverses the restriction requirement because the claims are not independent or distinct. The statutory basis for a restriction requirement reads as follows:

If two or more independent and distinct inventions are claimed in one application, the Director may require the application to be restricted to one of the inventions.

35 U.S.C. § 121 (emphasis added). Thus, the PTO may restrict an application only if the claimed invention satisfies both requirements (i.e., both independent and distinct). The Office Action only states that the claimed invention is distinct, but does not address the other requirement that the claims be independent. In the present case, Applicant submits that neither requirement is met.

The claims are not “independent” (i.e., not dependent) under 35 U.S.C. § 121. Namely, the claims disclose a relationship between the two or more subjects disclosed, that is, they are connected in design, operation, and effect. MPEP 802.01 give two examples of how claims can be “independent”; namely, (1) species under a genus which species are not usable together as disclosed; or (2) process and apparatus incapable of being used in practicing the process. Neither case exists here.

The claims also are not “distinct” under 35 U.S.C. § 121. MPEP 802.01 defines “distinct” as meaning that two or more subjects as disclosed are related, for example, as combination and part (subcombination) thereof, process and apparatus for its practice, process and product made, etc., but are capable of separate manufacture, use, or sale as claimed, and are patentable (novel and unobvious) over each other (though they may each be unpatentable because of the prior art). The present claims do not disclose two or more subjects, but rather disclose a single subject. Thus, the claims are not distinct.

Based on the foregoing, Applicant's request reconsideration and withdrawal of the restriction requirement.

The Applicants provisionally elect to prosecute Group I (claims 1-19).

Respectfully Submitted,


Victor C. Moreno (Reg. No. 40,732)
FROST BROWN TODD LLC
2500 PNC Center
201 East Fifth Street
Cincinnati, Ohio 45202-4182
513-651-6812 (direct)
513-651-6981 (fax)

CinLibrary 0021680.0515143 1508127v.1

Certificate of Mailing

The undersigned certifies that this correspondence was deposited with the U.S. Postal Service with sufficient postage as first-class mail and addressed to "Commissioner for Patents, PO Box 1450, Alexandria, VA 22313-1450," on this 8 day of June, 2005.

